

REMARKS

Claims 1 and 5-14 were pending in this application. In response to the Office Action dated February 9, 2004, claims 1, 8 and 11 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, figures and claims. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Applicants respectfully traverse the objection. The claims have been amended to remove the terms identified by the Examiner and, therefore, no amendments to the specification are believed to be necessary. Accordingly, the Examiner is requested to reconsider and withdraw the objection.

Claims 1 and 5-15 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse. Claims 1, 8 and 11 have been amended and Applicants submit that the claims, as amended, are in accordance with the second paragraph of 35 U.S.C. § 112. Accordingly, one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification. Therefore, it is respectfully submitted that the imposed rejection of claims 1 and 5-15 under 35 U.S.C. § 112, second paragraph is not legally viable and hence, solicit withdrawal thereof.

Claims 1 and 8 were rejected under 35 U.S.C. § 102(e) as being anticipated over Clark (U.S. Pat. No. 6,280,396). Applicants respectfully traverse the rejection.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the apparatus disclosed by Clark that would preclude the factual determination that Clark identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Independent claim 1 describes a bioelectrical impedance measuring apparatus. The apparatus comprises a housing and a plurality of rod-like electrode members, each having a plurality of electrodes, are disposed in an upper part of the housing. The upper part of the housing comprises two side edges, and the plurality of rod-like electrode members have a shape and a length such that an error derived from a change in a posture caused by a difference in a height can be minimized. The rod-like electrodes are arranged and fixed lengthwise along both side edges of the upper part of the housing. The apparatus also comprise a display device having the capability of an operator panel and lying between the electrode members and a weighing device included in a lower part of the housing. The housing accommodates a current supplying device for supplying current to the electrodes, a voltage measuring device for measuring voltage

at the electrodes; and an arithmetic means for calculating a bioelectrical impedance value from the supplied current value and the measured voltage values. It is noted that independent claim 8 include the limitations of claim 1 as well as a modem and a display device for displaying information which is acquired over an internet accessed through the modem.

Clark discloses that the length of the rod-like electrode member is a hand width as it is apparent from Fig. 1, Fig. 2 and Fig. 5. Therefore, it should be apparent that both a child and an adult cannot grasp the electrode member with same posture. Blood flow rate flowing in arms depends on height difference between a heart and both hands in bioelectrical impedance method measuring impedance between both hands. A difference of blood flow rate influences impedance. Therefore, blood flow rate reduces and impedance becomes higher and percent fat becomes higher when hands are higher than the heart. Thus, an error occurs from a change in a posture caused by a difference in a height in reference cited Clark.

In contrast, the electrode members of the present invention have a shape and a length such that an error derived from a change in a posture caused by a difference in a height can be minimized, as illustrated in Fig. 1. Therefore, both a child and an adult can maintain same posture when grasping the electrode members if he/she stretches his/her hands in horizontal direction. A further description is provided at page 7, line 22 to 24 of the specification. Accordingly, there are significant differences between the claimed invention and the apparatus disclosed by Clark that would preclude the factual determination that Clark identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. The Examiner is, therefore, requested to reconsider and withdraw the rejection of claims 1 and 8 under of 35 U.S.C. § 102.

Dependent claims 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark in view of Mault (U.S. Pat. No. 6,478,736). Applicants respectfully traverse the rejection for the reason set forth below.

Dependent claims 6, 7 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark in view of Mault and further in view of Kolawa et al. (U.S. Pat. No. 6,370,513). Applicants respectfully traverse the rejection for the reason set forth below.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants submit that there is no teaching, suggestion, or motivation to modify the apparatus of Clark to produce the claimed invention. The secondary references (Mault and Kolawa), either alone or in combination fail to remedy the above described deficiencies of Clark. Thus, even if the applied references are combined as suggested by the Examiner, and an Applicants do not agree that a requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, the rejections under 35 U.S.C. § 103(a) are not legally viable and should be withdrawn.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter. The Examiner indicated that independent claim 11 and dependent claims 12-14 would be allowable if rewritten to overcome the rejection under the second paragraph of 35 U.S.C. § 112.

Applicants submit that independent claim 11 has been amended. It is submitted that claim 11, as amended, is in compliance with the second paragraph of 35 U.S.C. § 112 and proper antecedent basis for each term is present. Accordingly, Applicants submit that independent claim 11 and dependent claims 12-14 are free from the applied art and in condition for allowance.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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